



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
06/686,908	12/27/84	LEMELSON	J

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EXAMINER	
SHAW, C	
ART UNIT	PAPER NUMBER
213	2

DATE MAILED: 08/30/85

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948.                  |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449       | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474      | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-20 are pending in the application.  
Of the above, claims \_\_\_\_\_ are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☒ Claims 1-7, 12, 15, 18 are allowed.
4. ☒ Claims 8-11, 13, 14, 16, 17, 19, 20 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☒ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable; ☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other \_\_\_\_\_

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The specification is objected to. On page 1 of the specification, applicant refers to the instant case as a continuation -in- part of serial no. 225,173 having parent application S.N. 515,147. In paper no. 18 of parent case S.N. 05/968,216, it was decided that the case was not a CIP of S.N. 225,173. Applicant is to delete the references to serial nos. 225,173 and 515,147 on page 1 of the specification.

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The oath is objected to. In his oath, applicant states that the instant case is "a continuation of ser. nos. 968,216 (Dec. 11, 1978) and ser. nos. 667,255; 506,887; 157,574; etc.". This statement is too vague. Applicant is to file a supplemental oath which explicitly sets forth all the parent cases of the instant case.

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Claims 1-7, 12, 15 and 18 are allowable over the prior art of record.

In view of the decision by the Board of Appeals in parent case S.N. 05/968,216 (paper no. 26 thereof), the claims are allowable over the prior art of record.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless-

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent.

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Claims 13 and 14 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Lee, Jr. et al..

The claims are broad enough to read on Lee, Jr.. Note that element ~~11~~ of Lee, Jr. constitutes the claimed memory and that col. 2, l. 40-50 of Lee, Jr. discusses a coated recording medium.

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Claims 11 and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Fraser.

Fraser discloses the subject matter claimed. Applicant is to note that he cannot rely on S.N. 225,173 for the teaching of a laser or for forming cavities.

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The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, as not providing support for the subject matter of claims 8-10, 16, 17, and 20.

The original specification does not provide support for the parallel tracks of claims 8-10 and 20, for the alphanumeric characters of claims 16 and 17 or for the scanning and deflecting of claim 17. The subject matter of these claims therefore constitutes new matter.

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Claims 8-10, 16, 17, and 20 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the above objection to the specification.

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References C-G are references cited during the prosecution of the parent case.

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8-21-85

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PRIMARY EXAMINER  
ART UNIT 213

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